

## **REMARKS/ARGUMENTS**

Applicant appreciates the Examiner's thorough search and examination of the present patent application.

Claims 1, 3-4, 6, 10 and 12-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Oscar et al. ("Oscar," U.S. Patent Application Publication No. 2001/0037216) in view of Ullman ("Ullman," U.S. Patent Application Publication No. 2002/0002495) and further in view of Freeman, Jr., et al. ("Freeman," U.S. Patent Application No. 6,012,035). Applicant respectfully traverses this rejection.

Applicant respectfully submits that elements defined in claim 1 are not taught, suggested or disclosed by either Oscar, Ullman and Freeman, nor does the combination of those references teach, suggest or disclose the missing elements of applicant's claim 1. Since elements of applicant's claim 1 are missing from each of Oscar, Ullman and Freeman, the combination of those references cannot render the claims obvious under 35 U.S.C. §103(a).

The missing elements in applicant's claim 1 are "identifying a sponsor for a prescription benefits plan," "designing the prescription benefits plan, to include a formulary of preferred medications," "identifying at least one eligible subscriber having a valid credit or debit account with a creditor or institution and wishing to participate in the prescription benefits plan," "enrolling each eligible subscriber who wishes to participate in the prescription benefits plan," "generating an eligibility profile for each subscriber," "establishing a prescription benefits manager to administer the prescription benefits plan." Moreover, the missing elements include "establishing a prescription claims processor" that "receives claims for prescription benefits from a participating pharmacy," "adjudicates the claims in accordance with the subscriber's eligibility profile," and "charges the subscriber's credit account for accepted claims, the amount of the charge being equal to the price of the prescription minus a predetermined co-payment which is tendered by the subscriber to the pharmacy at the time of fulfilling the prescription."

Furthermore, the missing elements include "a first payment, made by the creditor to the prescription benefits manager" that is "equal to the amount charged to the subscriber's account minus a first predetermined service fee to be retained by the creditor" and "a second payment, made by the prescription benefits manager to the pharmacy" that is "equal to a predetermined portion of the prescription price," a "third payment made by the prescription benefits manager to

the claims processor” that is “equal to a predetermined service fee.” Applicant addresses the Examiner’s rejection of claim 1 in connection with each of Oscar, Ullman and Freeman, respectively.

Instead of teaching the missing elements of applicant’s claim 1, Oscar is directed to a pharmacy benefits management system and method that provides pharmacy cost and clinical information to physicians and patients “to permit patients and physicians to become active participants in drug therapy decisions with cost factors being considered” (e.g., see Oscar, paragraph [0015]). Pharmacy benefits plan information and price information relating to “drugs in various classes” are correlated, and alternative drugs and expenses associated with alternative drugs are provided (see paragraph [0016]).

The Examiner cites to Oscar, paragraph [0049], lines 1-4 for teaching applicant’s claimed step of identifying a sponsor for a prescription benefits plan,” and cites to paragraphs [0043]-[0044] for teaching “designing the prescription benefits plan.” Applicant has carefully reviewed Oscar, including these cited passages, and respectfully disagrees with the Examiner. Oscar’s management server 110 interfaces with various servers, including pharmacy benefits management server 120, provider 130, recipient client 140 and sponsor client 150 via various modules. By interfacing with these otherwise disparate systems, Oscar is able to inform and/or suggest alternative medications to patients, thereby enabling patients to confer with their physicians to determine whether a particular alternative drug is appropriate, primarily for cost savings purposes. Interfacing with and gathering information from various sources to provide alternative therapies and medicines to patients is patentably distinct from applicant’s claimed step of “identifying a sponsor for a prescription benefits plan,” and “designing” the plan. Oscar is silent with regard to designing a prescription benefits plan, as well as to identifying a sponsor therefor.

Moreover, the Examiner cites to paragraphs [0050] and [0051] for teaching identifying at least one pharmacy that “participates in the prescription benefits plan,” “receives prescriptions for medication and prescription benefit claims from subscribers” and “fulfills the prescriptions for a predetermined price.” The cited paragraphs in Oscar, however, refer to users who have previously completed a registration process to access the management server 110. The registration process described in paragraphs [0048] and [0049] of Oscar enable users to select

various options that relate to a particular benefits plan the user “is subject to” (see paragraph [0049]), and not that is designed by Oscar’s system. Unlike applicant’s claim 1, no step of “identifying a subscriber for a prescription benefits plan” and “designing the prescription benefits plan” is taught or suggested by Oscar. Therefore, the steps identifying a pharmacy that participates in “the” plan, as well as corresponding steps associated with the pharmacy (e.g., receiving and fulfilling prescriptions) are not taught or suggested by Oscar.

Moreover, applicant disagrees with the Examiner’s characterization that Oscar, at cited paragraph [0050], teaches applicant’s claimed step of “enrolling” a subscriber into “the prescription benefits plan.” Instead, Oscar merely “displays a pharmacy benefits summary” as a function of interfacing with pharmacy benefits management server 120, provider 130, recipient client 140 and sponsor client 150. Unlike applicant’s claim 1, Oscar’s system does not design a prescription benefits plan and, further, does not “enroll” users therein.

Furthermore, applicant respectfully disagrees with the Examiner’s characterization that Oscar, at cited paragraph [0048], teaches applicant’s claimed step of “generating an eligibility profile” for each subscriber. The cited paragraph refers to registering users to access the management server 110, and does not describe an eligibility profile in which claims are adjudicated “in accordance” therewith. Instead, the cited paragraph relates to a “cookie” and corresponding information that identify the user to the management server 110.

Ullman, similarly, does not supply the missing elements. Ullman utilizes a standard electronic message format set by the National Council for Prescription Drug Programs (“NCPDP”), and adopts the “switch for an integrated system of instant adjudication, consumer data warehousing and incentive rewards for [a] consumer” (see paragraph [0023]). Unlike applicant’s claim 1, Ullman teaches that information regarding a “prescription, the patient, and his insurance, discount or savings coverage” is input into a computer, and transmit the information to appropriate “obligors or processors” (paragraph [0024]). Unlike applicant’s claim 1, Ullman does not teach or suggest “identifying a sponsor for a benefits plan,” and “designing the prescription benefits plan.” Accordingly, applicant disagrees with the Examiner’s position that Ullman teaches applicant’s claimed step of “identifying at least one eligible subscriber having a valid credit or debit account with a creditor or institution and wishing to participate in the prescription benefits plan.” Instead, Ullman’s integrated pharmaceutical accounts

management system adjudicates claims for patients who have previously enrolled and are currently participating in some plan. Ullman's system, unlike applicant's claim 1, "coordinates any benefits and data with other prescription benefit management systems through messages transmitted and received from any primary or secondary carrier systems (see abstract, Fig. 2, S4).

Further, Ullman does not teach or suggest applicant's claimed step of "establishing a prescription benefits manager to administer the prescription benefits plan." Ullman interfaces with and coordinates any benefits and data with other prescription benefit management systems through messages" (paragraph [0007]). Ullman does not regard administering any prescription benefits plans, and instead, serves to efficiently adjudicate and validate pharmaceutical transactions via third parties.

Freeman also does not teach or suggest the missing elements of applicant's claim 1. Freeman teaches supporting the delivery of health care. Freeman's system "maintains data storage of information," and manages entity intercommunications between "health care providers, health care facilities, a financial institution, and third party payors or subscribers" (see abstract, column 3, lines 35-45). Moreover, Freeman teaches "interfacing between the entities, storing records of ... transactions between entities, and providing statistical reports based on the transactions" (column 3, lines 35-45). However, Freeman does not teach or suggest "identifying a sponsor for a prescription benefits plan," nor "designing the prescription benefits plan," as defined in applicant's claim 1.

Freeman is cited by the Examiner for teaching "a first payment, made by the creditor to the prescription benefits manager, the first payment being equal to the amount charged to the subscriber's account minus a first predetermined service fee to be retained by the creditor," and cites to column 2, lines 38-41 for support. While Freeman mentions a financial institution retains a "transaction fee used to pay for the bank's services," Freeman is silent with respect to applicant's claimed step of "establishing a prescription benefits manager to administer the prescription benefits plan." As with Oscar and Ullman, Freeman does not purport to design a prescription benefits plan, nor does it purport to establish parties to administer the prescription benefits plan. Instead, Freeman describes a communication and data interface between otherwise disjointed parties, and storing data associated therewith.

Therefore, and for the foregoing reasons, applicant respectfully submits that even if one were to combine Oscar, Ullman and Freeman, as the Examiner has done (arguably using hindsight in view of applicant's disclosure and claimed invention), applicant's claim 1 still would not be taught because the missing elements are not taught, disclosed or suggested. Therefore, claim 1 is not obvious under 35 U.S.C. §103(a) over Oscar, Ullman and Freeman, and reconsideration is respectfully requested.

Claims 3-4, 6, 10 and 12-14 depend directly or indirectly from claim 1 and are, therefore, patentable for the same reasons as well as because of the combination of elements in those claims with the features set forth in the claim(s) from which they depend.

Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Oscar in view of Ullman and further in view of Freeman and Judge ("Judge," U.S. Patent Application Publication No. 2002/0111832). Applicant respectfully traverses this rejection.

Applicant respectfully submits that Judge does not teach or suggest the missing elements that are missing from the combined teachings of Oscar, Ullman and Freeman. Judge, instead, is directed to delivering a pharmaceutical prescription copay counselor over an internet protocol network. As described above with reference to Oscar, Ullman and Freeman, Judge does not teach or suggest applicant's missing elements, including "identifying a sponsor for a prescription benefits plan," and "designing the prescription benefits plan," and "enrolling each eligible subscriber who wishes to participate in the prescription benefits plan." Judge's tool, instead, "enables consumers and physicians, and others involved with prescription drug benefits, to identify lower cost and copay alternatives that are available within a third-party paid benefit" (see paragraph [0008]). Accordingly, applicant respectfully submits that the addition of Judge with Oscar, Ullman and Freeman does render applicant's claim 2, which depends directly from claim 1, obvious under 35 U.S.C. §103(a). Reconsideration is respectfully requested.

Claims 5, 7-9 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Oscar in view of Ullman and further in view of Freeman and Mayaud ("Mayaud," U.S. Patent No. 5,845,255). Applicant traverses this rejection.

Applicant respectfully submits that Mayaud does not teach or suggest the missing elements that are missing from the combined teachings of Oscar, Ullman and Freeman. Mayaud is directed to a clinical prescription management system for improving the quality of

prescriptions that are written by physicians (see column 4, lines 21-26). Unlike applicant's, claim 1, Mayaud does not regard a method of providing prescription benefits to subscribers under a plan, and, as described above with reference to Oscar, Ullman and Freeman, Mayaud does not teach or suggest the missing elements, including applicant's claimed steps of "identifying a sponsor for a prescription benefits plan," and "designing the prescription benefits plan," and "enrolling each eligible subscriber who wishes to participate in the prescription benefits plan."

Therefore, claims 5, 7-9 and 11, which depend directly or indirectly from claim 1, are patentable as well as because of the combination of features in those claims with the features set forth in the claim(s) from which they depend.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this application to issue.

THIS CORRESPONDENCE IS BEING  
SUBMITTED ELECTRONICALLY THROUGH  
THE PATENT AND TRADEMARK OFFICE EFS  
FILING SYSTEM ON August 3, 2007.

Respectfully submitted,



---

Josef J. Felber  
Registration No.: 59,642  
OSTROLENK, FABER, GERB & SOFFEN, LLP  
1180 Avenue of the Americas  
New York, New York 10036-8403  
Telephone: (212) 382-0700

LCD:JJF:ck